IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

REQUEST FOR FILING
(RULE 53(b)(1))

FOR DESIGN OR UTILITY APPLICATIONS
(DO **NOT** USE FOR CIPs)

jc698 U.S. PTO

01/08/02

00909

Rule 53(b)(1) PATENT APPLICATION:

☒ Continuation)
) application under 37 CFR 1.53(b)(1)
☐ Divisional)

of pending prior application of

Inventor(s): Takahashi et al.

Group Art Unit: 2872

Examiner: Shafer

Parent Appln. No.:	09	570,652	Atty. Dkt.	P 284144	OI67597N-US-DIV
	Series Code ⇧	Serial No. ⇧		New M#	Client Ref

Parent Filed: May 12, 2000
This Appln. Filed: January 8, 2002

Title: PRISM OPTICAL ELEMENT IMAGE OBSERVATION APPARATUS, AND IMAGE DISPLAY

Hon. Commissioner of Patents
Washington, DC 20231

Date: January 8, 2002
(Parent Matter No. 265151)

Sir:

To effect the above-requested filing today:

Attached is a copy **(which must be filed)** of the prior application, including:

☒ Abstract
☒ Specification and claims (109 pages) **(must be attached)**
☒ Drawings **(must be attached if originally filed):** 16 sheet(s)/set: ☐ 1 set informal;
☒ Formal of size ☒ A4 ☐ 11"

1A. Always X one box, only:
(1) ☒ Copy of Signed declaration or oath as originally filed in prior application **attached**
(2) ☐ NO declaration or fee is enclosed; therefore, this is a filing under Rule 53(f).

2. ☐ This application is hereby filed by <u>less than all of the inventors</u> named in the prior application. Petition is hereby made requesting deletion as inventor(s) of the following who is/are **not** inventor(s) of the invention being claimed in this application <u>(DELETE THE FOLLOWING INVENTOR(S)):</u>

1. _____
2. _____
3. _____
4. _____
5. _____
6. _____
7. _____
8. _____

2.5 THE <u>INVENTOR(S) FOR THIS NEW APPLICATION IS(ARE):</u>

1. _____
2. _____
3. _____
4. _____
5. _____
6. _____
7. _____
8. _____

3. The entire disclosure of the prior application is considered as being part of the disclosure of the accompanying application and is hereby incorporated therein by reference thereto.

30251841_1.DOC

PAT-108CN 11/01

4.   ☒   Priority is claimed under 35 U.S.C. 119/365 based on filing in   <u>Japan</u>   of

                                          (country)

	<u>Application No.</u>	<u>Filing Date</u>		<u>Application No.</u>	<u>Filing Date</u>
(1)	9-116724	May 7, 1997	(2)	9-116725	May 7, 1997
(3)			(4)		
(5)			(6)		

        a. ☐ _____ (No.) Certified copy/copies attached.

        b. ☒   Certified copy/copies previously filed on   <u>December 22, 1998</u>   in

               U.S. Application No.   <u>08/867,779</u>   , filed on   <u>June 5, 1997.</u>

                     series code ⇧   ⇧ <u>serial no.</u>

        c. ☐   Certified copy/copies filed during International stage of PCT/ _____ / _____ .

4(a).   (a) ☐   Domestic priority is claimed from PCT/ ____/____ ,   filed _____ .

        (b) ☐   Benefit is claimed of Provisional Application No.   60/____ , filed ____ .

5.   ☐   Assignee (optional)   _____

6.   ☒   Attached is the following number of Assignments (including original and all later successive ones by <u>different</u> assignors):   _1_   and respective **new** Cover Sheets. (Do **NOT** file old cover sheets.)

        (Assignments in parent **must be refiled** with new Cover Sheets in this continuing application if you want it/them recorded against the continuing application.)

        <u>Please return the recorded Assignment to the undersigned.</u>

7.   ☒   The power of attorney in the prior application is to<u> Glenn J. Perry, Reg. No. 28458</u>

        (Name and Reg. No.)
        whose current address is as in item 8 below.

        a. ☒   Recognize as associate attorney <u>Henry J. Daley, Reg. No. 42459</u> whose current address is as in item 8 below.
        (Name, Reg. No. and Address)

8.   **Address all future communications to Intellectual Property Group of Pillsbury Winthrop LLP, 1600 Tysons Boulevard, McLean, VA 22102**

9.   This application claims benefit of the following prior US application(s), the contents of which are incorporated into this application by this reference:

        No.   <u>09/</u>   <u>570,652</u>   filed   <u>May 12, 2000</u>

        No.   <u>08/</u>   <u>867,779</u>   filed   <u>June 3, 1997</u>

        No.   ____/____   filed   _____

        No. PCT/   ____/____   filed   _____ , which designated the U.S. and that International Application ☐ was   ☐ was not   published under PCT Acticle 21(2) in English

9(a).   ☒ See the attached Preliminary Amendment, which amends the first page of the specification to claim benefit of the above listed US application(s)

10.   **Small Entity Status →**   ☒ is <u>Not</u> claimed   ☐ is claimed (**pre-filing confirmation required**)

        __ (No.) Small Entity Statement(s) (<u>not</u> essential since 9/8/00) were/are:
        ☐ filed in above prior application
        ☐ attached.

11.   Petition to extend the life of the above prior application <u>to at least the date hereof</u>
(<u>one</u> box)   ☒ is being concurrently filed in that prior application (Use Form PAT-111).
(<u>must</u> be)   ☐ was previously filed in that prior application (Check length of prior extension).
(X'd)   ☐ is not necessary <u>for copendency</u> (**Double check** before X'ing this box).

12. ☒ **INFORMATION DISCLOSURE STATEMENT:** Attached is Form PTO-1449 listing all of the documents cited by Applicant and the PTO in the parent application(s) relied upon under 35 USC 120 and referenced in item 9 above. Per Rule 98(d) copies of those documents are <u>not required</u> now. Please consider those documents and <u>advise</u> that they have been considered in <u>this new</u> application as by returning a copy of the enclosed Form PTO-1449 with the Examiner's initials in the left column per MPEP 609. .

13. ☐ Attached is a Rule 103(a) Petition to Suspend Action.

14. ☐ **Please see** the attached Preliminary Amendment which reduces the number of claims for purposes of reducing the initial filing fee.

FILING FEE
THE FOLLOWING FILING FEE IS BASED ON
->->->-><u>CLAIMS AS FILED AND **CHANGED BY PRELIMINARY AMENDMENT IN ITEM 14**</u><-<-<-<-

<u>NOTE:</u>   If box 1A<u>2</u> is X'd, do not pay fees,
but leave lines 15-22 and 27-32 <u>blank.</u>

				Large/Small Entity		Fee Code
15. Basic Filing Fee . . . . .Design Application				$330/$165		106/26
16. Basic Filing Fee . . . . .Utility Application				$740/$370	+740	101/201
17. Total Effective Claims	71	minus 20 =	51	x $18/$9	+918	103/203
18. Independent Claims	6	minus 3 =	3	x $84/$42	+252	102/202
19. If any proper multiple dependent claim (ignore improper) is present,				$280/$140	+280	104/204
20.				**Subtotal =**	$2190	
21. If "petition" box 13 above is X'd, add petition fee. $130					+0	122
21A. If box 6 above is X'd, add Assignment recording fee . . . .$ 40					+40	581

22.   **TOTAL FILING FEE ATTACHED =** | $2230 |

(carry forward to Item 31)

23. ☐ ATTACHED:

24 ☒ See the attached Preliminary Amendment

25. ☐ See <u>NONPUBLICATION</u> REQUEST under Rule 213(a) attached (Pat-258)

26.
ADDITIONAL FEE CALCULATION FOR
PRELIMINARY AMENDMENT
<u>PER BOXES 24/25</u>

Claims remaining after amendment	Highest number previously paid for	Present Extra		Additional Fee

				Large/Small Entity		File Code

27. Total Effective Claims ***71** minus ** **71** = **0** x $18/$9 = $ **0** (103/203)

28. Independent Claims ***40** minus *** **40** = **0** x $84/$42 = + **0** (102/202)

29. If amendment enters proper multiple dependent claim(s) into this application for the <u>first time</u>, add (per application) . . . . $280/$140 + **0** (104/204)

30.   ADDITIONAL FEE $ **0**

31.   <u>plus</u> **FEE** from item 22 on page 3 + **2230**

32.   **TOTAL FEE ATTACHED** $ **2230**

*If the entry in this space is less than a entry in the next space, the "Present Extra" result is "0"

**If the "Highest number previously paid for" (see item 17 above) is less than 20, write "20" in this space

If the "Highest number previously paid for" (see item 18 above) is less than 3, write "3" in this space

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Our Deposit Account No. 03-3975
Our Order No.   9523 | 284144
          C#   M#

CHARGE STATEMENT: Upon the filing of a Declaration pursuant to Rule 60(b) or 60(d), the Commissioner is hereby authorized to charge any fee specifically authorized hereafter, or any missing or insufficient fee(s) filed, or asserted to be filed, or which should have been filed herewith or concerning any paper filed hereafter, and which may be required under Rules 16-18 <u>(missing or insufficient fee only)</u> now or hereafter relative to this application and the resulting Official document under Rule 20, or credit any overpayment, to our Account/Order Nos. shown above for which purpose a <u>duplicate</u> copy of this sheet is attached.
This CHARGE STATEMENT <u>does</u> <u>not</u> <u>authorize</u> charge of the <u>issue</u> <u>fee</u> until/unless an issue fee transmittal form is filed.

Pillsbury Winthrop LLP
Intellectual Property Group

By Atty: Henry J. Daley   Reg. No.   42459

Sig: _[signature]_   Fax: **(202) 833-8491**

Atty./Sec HJD/dlh   Tel: **(202) 775-9832**

NOTE No. 1: File this Request in <u>duplicate</u> with 2 postcard receipts (PAT-103) & attachments
NOTE No. 2: Is extension in parent necessary for copendency? **DOUBLE CHECK** Item 11 above.
If yes, printout Pat-111 and head it in <u>parent</u>.